APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,726	08/05/2003	Paul L. Jeran	10982225-2	8866

			EXAMINER	
7590	10/03/2006		NGUYEN, MADELEINE ANH VINH	

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ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>20 July 2006</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-8,10-15,21-26,29-32 and 34-42* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-8,10-15,21-26,29-32 and 34-42* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some *   c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)   4) ☐ Interview Summary (PTO-413)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   Paper No(s)/Mail Date. _____ .

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)   5) ☐ Notice of Informal Patent Application

     Paper No(s)/Mail Date _____ .   6) ☐ Other: _____ .

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed on July 20, 2006 have been fully considered but they are not

persuasive.

   a.   Applicant remarks that the combination of Ikenoue and Wolff is improper since

   the motivational rationale is insufficient in view of precedent set forth by the Federal

   Circuit, and accordingly, the office has failed to meet their burden of establishing a

   proper prima facie 103 rejection.

   It is noted that Wolff et al and Ikenoue et al references are both from the same field of

endeavor. Wolff teaches, "The present invention relates to the filed of document verification and

tracking; more particularly, the present invention relates to tracking, control, authentication and

verification of paper and electronic documents.: (col. 1, lines 8-11) with Ikenoue teaches, "The

present invention relates to an image forming apparatus such as a printer or a copying machine

for producing a copy and a management system therefor which can prevent illegal copying."

(col. 1, lines 12-15). Wolff discloses a system having a server subsystem 101 communicated

with a client subsystem 102 through network 103 for document verification and tracking.

Ikenoue discloses a system having a management unit 200 communicated with a client

subsystem 100-104 through telephone line 105 wherein the document can be printed by a printer

or copied by a copy machine. Wolff et al's invention is to prevent forgery (col. 1, lines 19-21),

"to verify validity of information in the document" (col. 2, line 16) while Ikenoue et al's

invention "can prevent illegal copying" (col. 1, lines 14-15), check for the validity of information

in the document (Fig.27; col. 13, line 53 – col. 14, line 13). The reason of the combination of

Wolff et al and Ikenoue et al is that Wolff does not specifically teach the copying of the original

document. Wolff et al generally teaches, "Each document would include encrypted information

(e.g., 2D bar who can make copies of the document. Intelligent copiers would then require an

authentication code or card before permitting the duplication of a document. Lists of who has

seen/copied the document may also be maintained by the server subsystem." That would have

been obvious to one skilled in the art at the time the invention was made as a matter of well

known in the art to interpret the above teaching of Wolff et al as the intelligent copiers

determines whether copying of the original document is permitted by comparing the information

in the document and copying the original document if copying of the original document is

permitted responsive to the determining. Ikenoue is combined with Wolff to support and clarify

the determining and copying steps in Wolff et al. Thus, the combination of Wolff and Ikenoue is

proper.

In addition, the test of obviousness is not whether the features of the reference may be

bodily incorporated into the other to produce the claimed subject matter but simply what the

references make obvious to one of ordinary skill in the art. In re Bozek, 163 USPQ 545, (CCPA

1969); In re Richman 165 USPQ 509, (CCPA 1970); In re Beckum, 169 USPQ 47 (CCPA 1971);

In re Sneed, 710 F.2d 1544, 218 USPQ 385. Furthermore, it is not necessary that the references

actually suggest, expressly or in so many words, the changes or improvement that applicant has

made. The test for combining references, is what the references as a whole would have

suggested to one of ordinary skill in the art. In re Sheckler, 168 UCPQ 716 (CCPA 1971); In re

McLaughlin 170 USPQ 209 (CCPA 1971); In re Young 159 USPQ 725 (CCPA 1968).

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-8, 10, 12-15, 21-26, 29-32, 34-42 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Wolff et al (US Patent No. 5,671, 282).

Concerning claims 1, 6, 29, 31 and 32, Wolff discloses a method of document

management, comprising providing a document comprising an original document (col. 3, lines

27-34), scanning the document with a scanning machine configured to determine if the original

document has a machine-readable code thereon (col. 5, lines 5-24), the scanning machine being

further configured to extract at least some information from the machine-readable code if the

machine readable code is present on the document (col. 5, lines 4-24); providing a database of

information (which reads on the storage of the electronic version of the document) that can be

present in the machine-readable code on the original document, the providing the database of

information comprising before the scanning (col. 3, lines 41-50 and col. 3, line 65 – col. 4, line

15), and comparing at least some of any information extracted from the machine-readable code

by the scanning machine with the information in the database to track the document (col. 3, lines

43-64). Wolff further teaches the step of storing a digital representation of the scanned version

of the document together with digital representations of other versions of the document using the

database (col. 5, lines 32-44); and determining that the digital representations of the other

versions of the document are in the database (col. 5, lines 32-43).

Wolff et al discloses the duplication of the document but does not directly teach the

determining whether copying of the original document is permitted and the copying of the

original document. However, Wolff teaches, "Each document would include encrypted

information (e.g., 2D bar who can make copies of the document. Intelligent copiers would then

require an authentication code or card before permitting the duplication of a document. Lists of

who has seen/copied the document may also be maintained by the server subsystem." That

would have been obvious to one skilled in the art at the time the invention was made as a matter

of well known in the art to interpret the above teaching of Wolff et al as the intelligent copiers

determines whether copying of the original document is permitted by comparing the information

in the document and copying the original document if copying of the original document is

permitted responsive to the determining. From the same field of endeavor, Ikenoue discloses an

image forming apparatus such as a printer or a copying machine for producing a copy and a

management system therefor which can prevent illegal copying wherein, the information

contained in machine-readable code defines if the document can copied, and wherein the copier

is configured to copy the document unless the scanning machine finds the machine-readable

code on the document and extracts information from the machine-readable code not authorizing

the copying (col. 2, lines 45-56; col. 10, lines 24-67; col. 11, lines 35-48). It would have been

obvious to one skilled in the art at the time the invention was made to combine the teaching of

Ikenoue to Wolff et al since Wolff also teaches forgery prevention of document reproduction and

the duplication of a document with the determination whether copying of the document is

permitted (col. 10, lines 50-57).

Concerning claims 2, 21, 22, 23, 24, 25, 26, 30, 34, 35, Wolff further teaches printing the

document with a printing device which prints the machine-readable code on the document, and

wherein the printing device is in data communication with the database (col. 4, lines 16-34),

(claim 2); the information contained in the machine readable code defines a version of the

document (col. 5, lines 50-51) and the scanning comprises scanning a scanned version of the

document (col. 5, lines 4-24), and further comprising: storing a digital representation of the

scanned version of the document together with digital representations of the others versions of

the document using the database (col. 5, lines 32-44); and determining that the digital

representations of the other versions of the document are in the database (col. 5, lines 32-43),

(claim 21); providing a hard image formed on output media (col. 3, lines 27-34), (claims 22, 23

and 26); the scanning machine is linked with a processor (101B) that is in data communication

with the database (101A) an in data communication with a second printer (101D), the processor

being configured to enable either the scanned version of the document or one of a plurality of

other versions of the document stored in the database as digital representations to be printed by

the second printer (col. 3, line 35 – col. 4, line 34), (claim 24, 34); printing the machine

generated code as the document is generated (col. 3, lines 27-50), (claim 25); storing the

machine-readable code as the additional information in the database (col. 3, lines 35-50), (claim

28); imaging the document after determining (col. 4, lines 16-28), (claim 30 and 35).

Concerning claims 3, 4, 7, 8, Wolff teaches the requirement and extraction of an

authentication code before permitting the duplication of a document but differs from claims 3, 4,

7, 8 in that he does not clearly disclose wherein the scanning machine is linked with a copying

machine configured for copying the document, wherein the information contained in the

machine-readable code defines if the document can be copied, and wherein the copier is configured to copy the document unless the scanning machine finds the machine-readable code on the document and extracts information from the machine-readable code not authorizing the copying. Ikenoue discloses an image forming apparatus and copy management system wherein a scanning machine is linked with a copying machine configured for copying a document, wherein the information contained in machine-readable code defines if the document can be copied, and wherein the copier is configured to copy the document unless the scanning machine finds the machine-readable code on the document and extracts information from the machine-readable code not authorizing the copying (col. 2, lines 45-56; col. 10, lines 24-67; col. 11, lines 35-48). It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of Ikenoue to Wolff et al since Wolff also teaches forgery prevention of document reproduction and the duplication of a document with the determination whether copying of the document is permitted (col. 10, lines 50-57) which indirectly means that the scanner can be linked with a copying machine or the scanner can be included in the copier machine.

Concerning claims 5, 10, 12, 13, 14, Wolff discloses the information included in the machine-readable code includes a storage location (address) of a file (col. 5, lines 50-63); the machine-readable code is printed with at least one of a resolution or tonal (density) difference that cannot be reproduced by the second copying machine (col. 8, lines 18-36), (claim 10); printing the code on copies of the document (col. 4, lines 16-34), (claims 12, 13, 14).

Concerning claim 15, Wolff differs from claim 15 in that he does not clearly disclose the second copying machine configured to identify a user requesting a copy of the document,

wherein the information contained in the machine-readable code defines if the document can be

copied by particular users, and wherein the second copying machine is configured to not copy

the document unless the scanning machine finds the machine-readable code and extracts

information from the code authorizing copying by an identified user. Ikenoue discloses

identifying a user requesting a copy of the document, wherein the information contained in the

machine-readable code defines if the document can be copied by particular users, and wherein

the second copying machine is configured to not copy the document unless the scanning machine

finds the machine-readable code and extracts information from the code authorizing copying by

an identified user (col. 2, lines 46-56). It would have been obvious to one skilled in the art at the

time the invention was made to have modified Wolff by the teaching of Ikenoue in order to

prevent forgery or illegal copying since both Ikenoue and Wolff et al are from the same field of

endeavor, and the purpose disclosed by Ikenoue would have been recognized in the pertinent art

of Wolff et al.

Concerning claims 36-42, Ikenoue further teaches that the determining comprises

determining only using the information of the comparing; using the information extracted from

the machine-readable code and the information in the database; determining without any

information regarding an individual attempting to copy the original document; the extracting

comprises extracting the information from the machine-readable code of the accessed document

corresponding to the first version; using the comparison of the extracted information with the

additional information; determine whether the copying of the original document is permitted

only using the extracted information and the additional information; determine whether the

copying of the original document is permitted without any information regarding an individual

attempting to copy the original document (Figs.2-7, 9; Abstract; col. 5, lines 21-37, lines 49-64;

col. 6, lines 33-67; col. 9, lines 46-61; col. 10, lines 11-18; col. 10, lines 24-35; col. 16, lines 1–

10, lines 33-38).

4.   Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff in view of

Ikenoue as applied to claim 6 above, and further in view of Jeran et al (US Patent No.

6,628,412).

Concerning claim 11, Wolff as modified differs from claim 11 in that he does not clearly

disclose that the machine-readable code is printed with an ink that is not visible when viewed

with only light in the visible wavelength range, the ink becoming visible when stimulated with

light outside of the visible wavelength range. Jeran discloses a document management method

wherein machine-readable code is printed with an ink that is not visible when viewed with only

light in the visible wavelength range (col. 3, lines 9-25). It would have been obvious to one

skilled in the art at the time the invention was made to have modified Wolff wherein the

machine-readable code is printed with an ink that is not visible when viewed with only light in

the visible wavelength range in order to easily hide the machine readable image as disclosed by

Jeran (col. In col. 3, lines 3-5).

Conclusion

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing
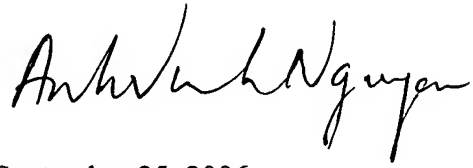
date of this final action.

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-

7466. The examiner can normally be reached on Tuesday-Thursday 12:30-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Edward L. Coles can be reached on 571 272-7402. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Madeleine A V Nguyen
Primary Examiner
Art Unit 2625

September 25, 2006